

(Practitioner's Docket No. IN-5554/BC1-0027)

REMARKS

1. **Rejection of claims 21, 27-31, and 33-37 under 35 U.S.C. 102(a) as being anticipated by Ott et al., WO 00/15725, hereafter "Ott" or "725".**

The rejection of the pending claims as anticipated by Ott has been maintained.

The Undersigned notes that Applicants' foreign priority date renders the instant rejection moot. The PTO's acknowledgement of the receipt of the certified copies of the priority documents is appreciated.

A copy of the translation of the certified priority document is being concurrently submitted under separate cover per MPEP 201.15 and 37 CFR 1.55 (a) (4). It is expected that upon the filing of the translation, Applicants will be entitled to rely upon the priority date to overcome the cited reference. Applicants' regret the inadvertent delay in making this submission.

2. **Rejection of claims 21 and 27-31 under 35 U.S.C. 102(b) as being anticipated by GB 778924, hereafter "924".**

The rejection of the pending claims as anticipated by the '924 reference has been maintained. The PTO states:

"The reference discloses polymeric compounds produced from 3,6-diethyl-1,8-octanediol. See page 4, lines 55 and 75-85. The position is taken that the skilled artisan would immediately envisage the use of the saturated diethyloctanediol within the disclosed polymers at page 4, lines 83-85. Furthermore, the position is taken in view of a polymer's definition requiring repeating units that the disclosed polymers inherently satisfy the argued "two or more monomer units" language."

(Office Action of 6/20/05, page 4)

Applicants greatly appreciate the detailed basis of rejection but must respectfully continue to disagree in regards to the invention of amended independent claim 21.

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A rejection for anticipation under section 102 requires that each and every limitation of the claimed invention be disclosed in a single prior art reference. *In re Paulsen*, 31 U.S.P.Q.2d 1671 (Fed Cir. 1994).

In this case, the invention of amended independent claim 21 requires a curable reaction product comprising two or more repeating units derived from a positionally isomeric diethyloctanediol and having a molecular weight polydispersity Mw/Mn of from 1.3 to 20.

GB '924 is silent as to the need to have a specific reaction product having at least two repeating units derived from a positionally isomeric diethyloctanediol and a specific polydispersity.

Moreover, as Applicants have previously noted, most of the 'glycol products' disclosed in GB '924 are outside the scope of Applicants' claimed invention, including all products within the scope of the formula set forth on page 1 and claim 1 of GB '924, given that R₄ must be an alkenyl. Indeed, the sentence at lines 79-84 appears to indicate that only nonhydrogenated glycols are intended to be used in the synthesis of 'drying oil' types of polyesters, i.e., see lines 53-58. Such nonhydrogenated glycols do not appear to encompass Applicants' positionally isomeric diethyloctanediols.

As a result, it is respectfully submitted that GB '924 fails to anticipate the invention of Applicants' amended independent claim 21.

In response, the PTO states:

the position is taken that the skilled artisan would immediately envisage the use of the saturated diethyloctanediol within the disclosed polymers at page 4, lines 75-85. Furthermore, the position is taken in view of a polymer's definition requiring repeating units that the disclosed polymers **inherently satisfy** the argued "two or more monomer units" language. With respect to applicants' arguments, to the extent that the meaning of "curable" is understood, the position is taken that the disclosed "drying oils" satisfy applicants' requirement that the composition be "curable" and contain the argued units.

(Office Action of December 5, 2005, pages 5 and 6., emphasis added.)

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Applicants appreciate the detailed remarks but must respectfully continue to disagree. In particular, Applicants question the basis for the PTO's position that the cited reference inherently anticipates the invention of claims 21, and questions the basis that the disclosed drying oils satisfy applicants' requirement that the composition be curable and contain the argued units.

First, Examiner states "that the disclosed polymers inherently satisfy the argued "two or more monomer units." "To support an anticipation rejection based on inherency, an examiner must provide factual and technical grounds establishing that the inherent feature necessarily flows from the teachings of the prior art. Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'l 1990). An element is inherently present when it is not specifically found in the prior device but is always present or flows naturally from what is taught there. Levi Strauss & Co. v. Golden Trade, 1995 WL710822*17 (S.D. N.Y. 1995).

This standard has not been met with the instant rejection. In particular, nothing except the teachings of Applicants' claimed invention suggest the particular elements required by the claimed inventions. Most importantly, Applicants' claimed invention does not always or necessarily flow from the disclosures of the cited reference. Moreover, the single source must disclose all of the claimed elements 'arranged as in the claim'. Richardson v. Suzuki Motor Co., 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

"It is incumbent upon the examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference. Ex Parte Levy, 17 U.S.P.Q.2d 1461 (Bd. Pat. App. & Int'l 1990). Until this standard is met, the cited reference fails to anticipate the claimed invention.

Further, the examiner continues to state that "the position has been taken [by the PTO] that the disclosed "drying oils" satisfy applicants' requirement that the composition be curable". However, the disclosed drying oils are not of a curable reaction product comprising two or more repeating units derived from a positionally isomeric diethyloctanediol." Specifically, the Examiner refers to the reference stating "These glycol

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products are useful in the synthesis of "drying oil." (page 4, lines 75-76). The antecedents for "these glycols" can be found in the prior two paragraphs wherein "these glycols" are described as "unsaturated glycols" (page 4, line 69) and a "C12 unsaturated glycols" (page 4, line 53).

The Examiner seems to agree with Applicants that "these glycols" are not "of a curable reaction product comprising two or more repeating units derived from a positionally isomeric diethyloctanediol," and that the glycols are not even saturated glycols. However, the Examiner has responded to this lack of teaching in the prior art by stating "the skilled artisan would immediately envisage the use of the saturated diethyloctanediol within the disclosed polymers at page 4." Applicant respectfully disagrees. Applicant submits that a skilled artisan would not recognize the claimed invention in the cited reference, wherein the reference discloses 3,6-diethyl-1,8-octanediol, and wherein the reference teaches using a different molecule in a drying oil.

The reference does not disclose all the claimed elements. Therefore, reconsideration and removal of the rejection is respectfully requested.

3. **Rejection of claims 21, 23, 25-37, 42 and 43 under 35 U.S.C. 102(a) as being anticipated by Bartol, EP 940459, hereafter "Bartol" or "459".**

The rejection of the pending claims as anticipated by Ott has been maintained and made final.

The Undersigned notes that Applicants' foreign priority date renders the instant rejection moot. The PTO's acknowledgement of the receipt of the certified copies of the priority documents is appreciated.

A copy of the translation of the certified priority document is being concurrently submitted under separate cover per MPEP 201.15 and 37 CFR 1.55 (a) (4). It is expected that upon the filing of the translation, Applicants will be entitled to rely upon the priority date to overcome the cited reference.

Applicants' regret the inadvertent delay in making this submission.

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4. Rejection of claims 21, 23, 25-37, 42 and 43 under 35 U.S.C. §103(a) as unpatentable over Ott et al., (WO 00/15725), hereafter "Ott" or "725", or National Distillers Products Corporation (GB 778924) hereafter "National Distillers" or "GB '924", or Bartol et al., (EP 0940459 (A2,A3)), hereafter "Bartol" or "EP '459".

It is the PTO's position that it would have been obvious to utilize any isomer of diethyloctanediol in the production of polymers, based upon a teaching of the individually cited references.

Applicants appreciate the detailed basis of rejection but must respectfully disagree.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

MPEP 2143.

This standard is not met with any of the above individually cited references.

Most particularly, Applicants must respectfully submit that the inventions of claims 21 or 42 require more than a suggestion to use a diethyloctane monomer in the production of polymers. Rather, Applicants' claimed invention centers on a curable composition that contains a curable polymerized reaction product of a positionally isomeric diethyloctanediol monomer, i.e., a polymerized reaction product being one containing two or more monomer units. The PTO has taken the position that Applicants' use of "curable" language is not adequately defined. However, Applicants' Specification on page 18, lines 16-29 expressly teaches curable polymers in one embodiment, 'the inventive oligomers and polymers', i.e., the curable reaction product, will contain functional groups which undergo crosslinking reactions with complementary functional groups. The complementary functional groups can be present in the curable reaction

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product or in a separate compound. Thus, the inventive oligomers and polymers can be "self-crosslinking" or "externally crosslinking".

The fact that a diethyloctane monomer was polymerized as a result of the *curing* of prior art coating compositions is irrelevant in regards to patentability of the instantly claimed compositions. That is, such cured compositions fail to disclose or suggest Applicants' claimed curable composition comprising a curable reaction product comprising two or more monomer units of diethyloctane monomer.

Indeed, as previously noted, the crucial factor is what effect such obviousness of structure has upon the obviousness of the subject matter as a whole, since structural obviousness alone is not a bar under 35 U.S.C. §103 to the grant of a patent on a chemical compound. *Comr. Pats. v. Deutsche Gold- und Silber, etc.* 157 U.S.P.Q. 549 (C.A.D.C. 1968). In this case, the prior art compositions fail to disclose a curable composition that relies upon a *curable* reaction product of diethyloctanediol monomer.

A *prima facie* case of obviousness based on structure exists if the prior art suggests to one of ordinary skill in the art to make the substitution or modification. *In re Taborsky*, 183 U.S.P.Q. 50 (C.C.P.A. 1974).

In addition, as noted above, each of the cited references fails to disclose Applicants' requirement of a reaction product comprising two or more repeating units. No additional references have been cited by the PTO to correct these identified deficiencies. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 180 USPQ 580 (C.C.P.A. 1974); MPEP 1243.03.

Further, claim 42 specifically claims two or more monomer units being derived from a positionally isomeric diethyloctanediol monomer that is one of a 2,4-diethyloctanediol or a diethyloctane-1,5-diol. Nothing in the individually cited references disclose the two or more monomer units being derived from a positionally isomeric diethyloctanediol monomer that is one of a 2,4-diethyloctanediol or a diethyloctane-1,5-diol. Therefore, it would not have been

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obvious for a skilled artisan to expect success in choosing this particular group of diethyloctanediol among all other diethyloctanediols.

Finally, nothing in any of the individually cited references provides the motivation to require Applicants' specific reaction product having a particular polydispersity. The prior art must provide one of ordinary skill in the art the motivation to make the proposed molecular modifications needed to arrive at the claimed compound. *In re Lalu*, 223 U.S.P.Q. 1257 (Fed. Cir. 1984).

In the absence of any motivation to do what Applicants have done, it is respectfully submitted that each of the individually cited references fails to provide a *prima facie* case of obviousness.

Reconsideration and removal of the rejections is respectfully requested.

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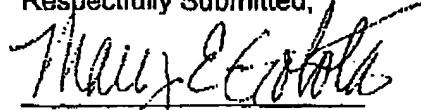
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CONCLUSION

Applicant(s) respectfully submit that the Application and pending claims are patentable in view of the foregoing amendments and/or remarks. A Notice of Allowance is respectfully requested. As always, the Examiner is encouraged to contact the Undersigned by telephone if direct conversation would be helpful.

Respectfully Submitted,



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